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MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			CUMMING, WILLIAM D	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/617,074

Filing Date: July 10, 2003

Appellant(s): SCOTT PREECE

MATTHEW C. LOPPNOW  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the remand from the Board of Appeals and Interferences of

October 23, 2007

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-8 and 15-20.

Claims 21-26 are allowed.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Appellant's brief presents arguments relating to the drawings. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

**(7) *Grouping of Claims***

The rejection of claims 1-8 and 15-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

a. Claims 1-8 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an enabling disclosure on how a user with a radio telephone when in a no-coverage area, as stated by the specification that the radio telephone system (last known) and the radio telephone cannot communicate, can be "used" to obtain any service from the radio telephone system. Since the radio telephone, according to the claim is in the no-coverage area of that last known radio telephone system as stated in claims 1, 9, and 15. Returning the radio telephone to a coverage area to obtain service is critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure according to In re Mayhew, 527 F. 2d 1229, 188 USPQ 356 (CCPA 1976).

The radio telephone or user never can obtain service when in a no-coverage area, the radio telephone informs the user how to get back to the coverage area to obtain service and once back in the coverage area, only then, the user and radio telephone obtains service.

b. Claims 5 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe the location system independent of the communication system as stated by claim 5 and the location broadcasting network access points as stated by claim 8. These items are not discloses where they even are and how they interact with other items of the system and method. The "*written description*" of the invention required by first paragraph of 35 USC §112 is separate and distinct from that paragraph's requirement of enabling disclosure, since description must do more than merely provide explanation of how to "*make and use*" the invention. Applicant must also convey, with reasonable clarity to those skilled in the art, that applicant, as of the filing date sought, was in possession of the invention, with the invention being, for purpose of "*written description*" inquiry, whatever is presently claimed. Drawings alone may, under proper circumstances, provide "*written description*" of the invention required by 35 USC §112, and whether the drawings are from design application or utility application is not determinative. In order to satisfy "*written description*" requirement of 35

USC §112, the proper test is whether drawings conveys, with reasonable clarity to those of ordinary skill in the art, the claim subject matter.

c. Claims 1-8 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 9, and 15, these claims are confusing since obtaining service from a no-coverage area of a radiotelephone communication system. By definition a no-coverage area does not have any service. If the radiotelephone can receive service, by definition, it cannot be a no-service area. Claims 1, 9, and 15 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which appellant regard as their invention. Evidence that claims 1, 9, and 15 fails to correspond in scope with that which applicant regards as the invention can be found in the reply filed April 27, 2006. In that paper, appellant has stated obtain service while the radio is in a no coverage area, and this statement indicates that the invention is different from what is defined in the claim because the claims state as such. Appellant that there is no step of obtaining service, but claim 1 clearly states “*...using the information to obtain service...*” Appellant also argues that the step or optional, “*can be used*”, which is also not Appellant’s claimed invention.

d. Claims 1-8 and 15-20 are rejected under 35 U.S.C. 101 because the invention is inoperative and therefore lacks utility. It is impossible to obtain service from a no-coverage area of a radiotelephone communication system since inherently a no coverage area does not have any service.

**(11) Response to Argument**

Regarding appellant's arguments on pages 5 and 6 on enablement. Appellant totally intently ignores and scoffs at *In re Mayhew* which states a feature which is taught as critical in a specification, the radiotelephone moving into a radiotelephone service area to obtain service, and is not recited in the claims should result in a rejection of such claim under the enablement provision section of **35 U.S.C. § 112**. The examiner is following MPEP § 2164.08(c).

Regarding arguments on page 6, a written description requirement issue generally involves the question of whether the subject matter of a claim is supported by [conforms to] the disclosure of an application as filed. If the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under **35 U.S.C. 112**, first paragraph. Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date

sought, appellant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.

*Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). The specification inadequately describe the location system independent of the communication system as stated by claim 5 and the location broadcasting network access points as stated by claim 8. These items are not discloses where they even are.

Regarding arguments on page 6 and 7, although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In *Cohn*, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an "opaque" appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after

treatment were inherently inconsistent and rendered the claim indefinite.

The examiner is following MPEP § 2173.03. Also the claims contradict its self. These claims are confusing since obtaining service from a no-coverage area of a radiotelephone communication system. By definition a no coverage area does not have any service. If the radiotelephone can receive service, by definition, it cannot be a no-service area. Also Appellant's arguments even confused the matter even more. The examiner even suggested claim language to appellant to improve the clarity or precision of the language used.

Regarding arguments on pages 7 and 8, an invention that is "*inoperative*" (i.e., it does not operate to produce the results claimed by the patent applicant) is not a "*useful*" invention in the meaning of the patent law. See, e.g., *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) ("*An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful.*"). The utility asserted by the appellant was thought to be "*incredible in the light of the knowledge of the art, or factually misleading*" when initially considered by the examiner. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). The underlying finding by the examiner in these cases was that, based on the factual record of the case, it was clear that the invention could not and did not work as the appellant claimed it did. It is impossible to

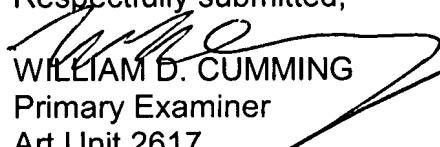
obtain service from a no-coverage area of a radiotelephone communication system since inherently a no-coverage area does not have any service.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

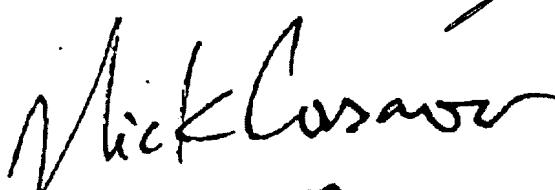
Respectfully submitted,

  
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wdc  
October 23, 2007

Conferees

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